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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,714	01/20/2004	Hua Wang	137825-1	3685

6147 7590 04/20/2005

GENERAL ELECTRIC COMPANY
GLOBAL RESEARCH
PATENT DOCKET RM. BLDG. K1-4A59
NISKAYUNA, NY 12309

EXAMINER

HAMPTON HIGHTOWER, PATRICIA

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/761,714

Applicant(s)

WANG ET AL.

Examiner

Patricia Hightower

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 and 53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-50 and 53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/3/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Information Disclosure Statement

The information disclosure statement filed February 03, 2005 has been considered and has been made of record.

Response to Amendment

In response to the amendment/response filed January 28, 2005 the rejections of the claims under 35 USC 102(e) as being anticipated by US20040166323 and US 20030175488 have been withdrawn because the "488 reference does not teach a multilayer article assembling having an adhesive layer comprising a polyurethane and an uncured thermoset or uncured cyclic oligomer substrate layer and the '323 reference does not teach the use of a polyurethane in the adhesive layer. The cancellation of claims 51 and 53 renders the rejection of said claims under 35 USC 112, second paragraph moot.

However, the provisional rejection of the claims under the judicially created doctrine of obviousness-type double patenting rejection over copending application 10/737,944 has been modified by including USP 5,103,336 (newly cited) because the copending application does not claims a multilayer article having an adhesive/tie layer comprising a polyurethane in combination with an uncured thermoset or uncured cyclic oligomer substrate layer.

Obviousness-type Double Patenting Rejection

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

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F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-50 and 53 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-81 of copending Application No. 10/737,944 in view of USP 5,103,336 (newly cited). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application and the copending application are viewed as claiming overlapping subject matter that is viewed as not being patentably distinct because the claimed multilayer article comprising 4 distinct layers comprising a coating layer a copolyestercarbonate derived from at least one 1,3-dihydroxybenzene and at least one aromatic dicarboxylic acid (ii) a second layer comprising a polymer with structural carbonate units, (iii) an adhesive layer comprising a polyurethane and (iv) an uncured thermoset or uncured cyclic oligomer substrate layer wherein the coating layer is in contiguous contact with the second layer and the adhesive layer is contiguous contact with the second layer and the substrate layer and the method of preparing the multilayer assembly; differs from the copending application multilayer article and method of preparing by the use of a polyurethane in the adhesive layer.

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The copending application claimed multilayer material and method of making differ from the instant application in that it does not disclose a polyurethane in the adhesive layer.

USP 5,103,336 teaches at col. 2, lines 5-64, col. 3, lines 1-64, a multilayered security window structure (laminate) comprising a polycarbonate layer, a suitable adhesive layer and an electrically controlled optical shutter layer, wherein the adhesive layer may be any transparent substance, preferably organic that has a melting temperature below the softening temperature of the electrically controlled optical light value material and is capable of bonding the liquid crystal material layer (the electrically controlled optical light value material) to the polycarbonate layers by surface attachment at this melting temperature. If the melting/adhesion temperature of the adhesive layer is too high, adhesion of the layers will result in adverse effects upon the electrically controlled light value rendering it inoperable for controlling light transmission through the laminate. The preferred adhesive layer is a polyurethane resin produced by the condensation reaction of a polyisocyanate with a hydroxyl-containing material. Suitable adhesive layers include a film comprising a polyurethane formed from at least one aliphatic or cycloaliphatic diisocyanate, at least one polyol chosen from among the polyester diols, the polycaprolactone diols, the polycarbonate diols and the polybutadiene diols and at least one chain-lengthening agent. It would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the teaching of USP 5,103,336 that the polyurethane adhesive layer as taught by USP

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5,103,336 could have been incorporated into the adhesive layer of the instantly claimed multilayer assembly or article thereby obtaining the instant invention as claimed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant's arguments with respect to claims 1-50 and 53 have been considered but are moot in view of the new ground(s) of rejection.

Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. These references are cited to show the state of the art of multilayer articles; Wang, Brink and Graf.

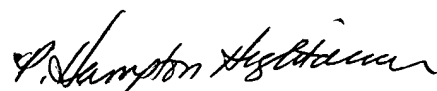
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia Hightower whose telephone number is (571) 272-1073. The examiner can normally be reached on M-F from 9:30 A.M. - 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read "P. Hampton Hightower".

P. Hampton Hightower
Primary Examiner
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P. Hightower:ph
April 16, 2005